



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 10/680,830 | 08/12/2005 | Timothy Raymond Cronin | | 5367 |

7590
Timothy Raymond Cronin
P.O. Box 291
Portage, WI 53901

04/01/2010

| |
|----------|
| EXAMINER |
|----------|

HARVEY, DAVID E

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2621

| | |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

04/01/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/680,830
Filing Date: August 12, 2005
Appellant(s): CRONIN, TIMOTHY RAYMOND

Mr. Timothy Raymond Cronin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal briefs filed 6/25/2009 (and 4/24/2009) appealing from the Office action mailed 2/23/2009.

(A) Preface to the Answer:

1) The Appeal Brief filed 6/25/2009 (which refers to the Brief filed 4/24/2009) is non-compliant. However, being that the instant applicant is pro se, in accordance with MPEP 1205.02, the Appeal Brief of 6/25/2009 has been accepted by the Appeal Brief Processing Center [indicated via email sent to the instant examiner (which can be provided, upon request)];

2) Should applicant decide that a Supplemental Brief is needed to respond to this Answer, then applicant should be sure to file the Supplemental Brief in the proper format (i.e., including the Headings listed in this Answer, appropriate discussion under each heading, and the required appendices attached thereto);

3) For the record, the examiner notes that he has reviewed the submitted references included with the appeal Brief of 4/24/2009.

(1) Real Party in Interest

Applicant is pro se.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal [e.g., **Note part 9 on page 4 of the Brief Filed 6/25/2009**].

(3) Status of Claims

There is only a single unamended claim pending in the instant application. This claim stands rejected under Sections 101, 112-1, and 102.

(4) Status of Amendments After Final

No amendments were filed after the Final Rejection (or indeed, during the present prosecution).

(5) Summary of Claimed Subject Matter

As disclosed, Applicant's claimed invention pertains to "the adding of value" to A/V "recordings", which added value cannot be easily copied. More specifically, applicant's invention is directed to A/V "recordings" that are "certified verifiable subliminal free", so as to make these "recordings" more desirable to the consumer relative to "recordings" that are not "certified verifiable subliminal free".

(6) Grounds of Rejection to be Reviewed on Appeal

A) The instant claim has been rejected under the following Sections:

- 1) 35 USC 101;
- 2) 35 USC 112-1; and
- 3) 35 USC 102(b);

(i.e., the "grounds of rejection to be reviewed").

B) It is noted that applicant continues to submit arguments alleging that the instant application is entitled to an earlier filing date. However, the examiner notes:

- 1) That this issue is not an appealable issue; and
- 2) That the issue was previously considered and addressed by the Office as indicated in the "Petition Decision" mailed 10/18/2006.

(7) Claims Appendix

The copy of the appealed claim contained in Appendix C of the Brief filed 6/25/2009 is correct. However, for Boards convenience, the lone pending claim reads as follows:

***“Certified verifiable subliminal-free
audio recordings,
recordings containing both audio and video content,
and visual recordings.”***

(8) Evidence Relied Upon

| | | |
|---------|------------|--------|
| 5526125 | Mori et al | 6/1996 |
| 6122322 | Jandel | 9/2000 |

(9) Preface to the Rejections:

I. The claimed invention (as argued):

1) In the response filed 11/04/2008 [e.g., the first paragraph on page 2; the first 3 lines on page 4; the sixth paragraph on page 4; the last paragraph on page 5; etc,...], applicant argued/suggested that his invention pertains to a “method” and/or “process” of producing “recordings”. It was noted that, if this position is true, then the instant claim(s) should be drafted to positively forth the “active steps of manipulation” which comprise said alleged inventive method/process - i.e., as is required of method/process claims. Claim 1 of the above cited Jandel Patent was cited to applicant as being illustrative of the proper form of method claims.

The examiner further noted, however, that the mere “*idea*” (i.e., non-functional descriptive recitations) of “certified verifiable subliminal free recordings” is not itself patentable [e.g., such subject matter does not fall within one of the statutory classes of patentable inventions defined by section 101].

2) In the response filed 11/4/2008 [e.g., lines 20-34 on page 4], applicant described “steps” that he regarded as comprising the alleged process/method of his invention. It was noted, however, that that these cited/argued “steps” are not recited in the pending claim, and also that the cited/argued steps are not tied to a machine/apparatus [as required under Section 101].

3) In the response filed 11/4/2008 [e.g., third paragraph on page 2], applicant took the position that “subliminal messages are never “undetectable” because, “by definition”, they are detected “unconsciously” by the human observer. The examiner disagrees. As currently understood by the examiner “subliminal messages”, by definition, refer to a message that is not “consciously” detected by the user. The issue as to whether such “subliminal messages” are actually detected subconsciously/“unconsciously” by the observer has long been a matter of debate in the scientific community. There seems to be no way to prove/disprove whether a message/stimuli that is presented to the observer at an unconscious level is, or can be, perceived by the observer at a subconscious/“unconscious” level.

4) Given that which is set forth in part “3” of this section, for one skilled in the art to actually “verify” a “recording” to be free of subliminal messages, it would appear that one would require some type of method/device that is capable of “consciously”/physically detecting any and all subliminal

Art Unit: 2621

messages, i.e., messages that cannot be detected consciously by a human observer, that may have added to the recording.

To the point, it is noted that a conventional form of subliminal audio messaging comprises a secondary audio content that is added to the primary audio content at such a low volume/amplitude that it cannot be detected consciously by the observer; i.e., a background singer whispers a message into the microphone at a subliminal amplitude. The instant disclosure, as originally filed, does not describe any method/process/device by which such subliminal messages can possibly be detected and, as such, does not describe any method/process/device by which a recording can be "certified" as being free of subliminal messages **in any "verifiable" way** in accordance with the requirements of Section 112-1. That is, the disclosure does not describe any way of physically detecting what cannot be consciously detected by a human.

5) As argued by applicant in the response filed 11/04/2008:

a) "Certification" allegedly refers to the attachment of some unspecified type of a label/status to a "recording" which identifies the recording as being free of subliminal messages; and

b) "Verifiable" allegedly refers to some kind of documentation and/or paper trail that may be provided in support of said "Certification".

Even if these definitions are accepted such terminology, at best, constitutes non-functional descriptive material, and does not define active steps of manipulation required of a method claim [i.e., the alleged invention (note lines 1-4 of page 2 of the amendment filed 11/4/2008)]; i.e., albeit, the pending claim, as recited, are actually directed to "recordings", per se.

II. State-of-the-art [as evidenced via the showing of Jandel (U.S. Patent #6,122,322)]:

1) Jandel has been cited because it evidences that it was known to be desirable to protect an observer from subliminal messages present in video, still image, and audio media:

"The protection of an observer from such messages is more difficult to achieve in modern types of communications, such as Internet and videotelephony, for instance. Subliminal messages can be hidden not only in a video sequence, but also in still images, or what the observer considers to be still images, and also audio sequences" [Note lines 32-37 of column 1].

Art Unit: 2621

2) In an attempt to provide an observer with such desired “protection”, Jandel discloses a system that comprises:

a) Circuitry for detecting a specific type of subliminal messaging in a received video sequence; and

b) Generating and alarm warning the observer as to the detection of said specific type of subliminal messaging in the received video sequence.

Here it is noted that when the system does not detect this specific type of subliminal messaging in the received video sequence the system inherently “**verifies**” the video sequence in **free of said detectable type of subliminal messaging**.

3) The examiner notes that despite the fact that Jandel recognized the desire to protect the observer from various other forms of subliminal messages, e.g., such as subliminal messages in audio sequences (note part “1” of this section), the invention disclosed by Jandel only detects/protects the observer from a specific detectable type of message in video sequences; i.e., as such, Jandel is not capable of certifying a signal to be “free” of subliminal messages, as claimed. While not explicitly stated in Jandel, the examiner maintains that this is because subliminal messages are, by definition, messages that are hidden from the human observer (i.e., thereby making the majority of conventional subliminal messages simply undetectable, consciously and physically/mechanically).

III. Issues pertaining to the claimed invention:

1) As addressed above, the examiner maintains that most conventional forms of subliminal messaging are simply undetectable. Given the undetectable nature of conventional subliminal messaging, the question arises as to the meaning/scope of the recitation “**certified verifiable subliminal free ... recordings**” recited in the pending claim. That is, if subliminal messages are undetectable, then how can one possibly “certify” and “verify” a recording to be free of subliminal messages? - i.e., how can one certify and verify a “recording” to be free of undetectable content? The following is noted:

a) The examiner maintains that it is unclear from the instant disclosure how and/or by what means/process the recited recordings are “certified” to be “subliminal-free” in a way that is “verifiable”;

Art Unit: 2621

b) To the extent that the meaning of the disclosed invention was explained by applicant in the communication of 6/19/2008, it appears that the invention pertains to a method/process by which audio/visual recordings are produced in a "secure production environment", thereby enabling the "manufacturer" of the recordings to "**certify**" (i.e., in some unspecified manner) that the recording, and copies thereof, are "free" of subliminal messages [note lines 1-7 of paragraph 0004 of the instant specification]. The disclosure suggests that this unspecified "certification" is somehow "verifiable", however, the instant disclosure does not appear to describe how such verification is accomplished and/or is possible; i.e., again given the fact that such messages are, by definition, undetectable;

c) Contrary to these arguments of 6/19/2008, the instant claim does not recite a "method" of producing the recordings being that the claim clearly fails to positively set forth "steps" for performing a method; i.e., the "certified" and "verifiable" recitations, at best, constitute non-functional descriptive material;

d) Even if one were to accept applicant's own interpretation of the instant invention, it is the examiner's position that the scope of claim 1 encompasses (i.e., is anticipated by) the notoriously well known process by which home users conventionally produced/"manufactured" home videos using conventional video cameras and home editing/dubbing units. That is the "home production environment", like applicant's own production studio environment, constitutes a "secure" environment in which the home user (i.e., the "manufacturer" of home A/V recordings) produces "recordings" that are likewise free of subliminal messages in the same certifiable/verifiable manner offered by production in a "secure" environment.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The instant claim (hereafter “claim 1”) is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant claim, as currently drafted [note item “(7)” above], is directed to audio/visual “recordings” per se and, as such, fails to set forth a new and useful process, machine, manufacture, or composition of matter, as required under section 101.

With respect to applicant’s arguments:

1) In the response filed 11/04/2008 [e.g., the first paragraph on page 2; the first 3 lines on page 4; the sixth paragraph on page 4; the last paragraph on page 5; etc,...], applicant argued/suggested that his invention is directed to a “method” and/or “process”. It was noted that if this position was in fact true, then the instant claim should be drafted to positively forth the “active steps of manipulation” which comprise said alleged method/process - i.e., as is required of method/process claims. Claim 1 of the above cited Jandel Patent was cited to illustrate the proper format of a method claim;

2) The examiner contends that the mere “*idea*” (i.e., non-functional descriptive material) of “certified verifiable subliminal free recordings” is not itself patentable [e.g., such subject matter does not fall within one of the statutory classes of patentable inventions defined by section 101]; and

3) In the response filed 11/4/2008 [e.g., lines 20-34 on page 4], applicant appears to have set forth “steps” that he regards as comprising the process/method of his invention. It is noted, however, that that these “steps” are not recited in the pending claim, and that these steps are not tied to a machine/apparatus [as required under Section 101].

3. The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Instant “claim 1” is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The following is noted:

As addressed above in item “(9)” [e.g., @ paragraph “4)” of section “I.”], it is unclear from the instant disclosure as to:

A) How and/or by what means/process the recited “recordings” are in fact “**certified**” as being subliminal-free (i.e., how and by what means/process is such “certification” performed/accomplished/determined?); and

B) How and/or by what mean/process this recited certification is actually verified and/or “verifiable”?

Clarification is required.

With respect to the arguments:

1) In the response filed 11/4/2008 [e.g., third paragraph on page 2], applicant took the position that “subliminal messages are never “undetectable” because, “by definition”, they are detected “unconsciously” by the human observer. The examiner disagrees. As currently understood by the examiner “subliminal messages”, by definition, refers to stimulus that is not detected “consciously” by the user. The issue as to whether “subliminal messages” are, or can be, detected subconsciously/“unconsciously” by an observer is a matter of debate/speculation. There seems to be no way to prove/disprove at what level a stimuli, i.e., subliminal

Art Unit: 2621

messages, may or may not be detected “sub-consciously/unconsciously” by an observer.

2) Being such, for one skilled in the art to actually “verify” a “recording” to be free of subliminal messages, it would appear that one would require some type of method/device which is capable of “consciously”/physically detecting stimuli that, by definition, is hidden from and can’t be detected consciously by the observer. The instant disclosure does not appear to describe any method/process/device by which such messages can be detected; i.e., thus any way that a recording can be “certified” as being free of subliminal messages *in a “verifiable” manner* [i.e., any way of physical/“consciously” detecting what can only be detected unconsciously].

3) In summary, if subliminal messages are literally hidden in a recording, then how can one possibly “certify” and “verify” a “recording” to be free of subliminal messages - i.e., how can one certify and verify a “recording” to be free of content that is itself hidden/undetectable?.

Art Unit: 2621

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Instant “Claim 1” is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,526,125 to Mori et al.

As is shown in Figure 1, Mori et al. illustrates an audio/visual production system for producing/“manufacturing” (@ 1) audio/visual recordings and (@ 2) copies thereof in a “secure” user/home environment. As such, the user is implicitly capable of certifying and verifying, to the extent possible, that the master audio/visual recordings produced thereby (@1), and produced audio/visual recording copies thereof (@2), are free of subliminal messages; i.e., as construed in accordance with the instant specification. As such, these home “recordings” anticipate the recitations of instant claim 1.

With respect to the arguments:

1) Applicant argues/suggests that “certified verifiable subliminal recordings” of the instant claim exist when such recording are produced within a “secure” manufacturing environment. To the extent that that this is true, it is maintained by the examiner that the “prior art” of Mori et al is sufficient to meet these non-functional descriptive recitations of the claim in that the “recordings” described in Mori et al, are likewise produced within a “secured” home environment of the user; i.e., wherein the user/“manufacturer” of the home “recordings” in Mori et al clearly produced recordings that are certified verifiable, by the user, to be subliminal free.

Art Unit: 2621

(11) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/DAVID E HARVEY/
Primary Examiner
AU 2621

Conferees:

/Marsha D. Banks-Harold/

Supervisory Patent Examiner, Art Unit 2621

Ms. Marsha Banks-Harold
SPE (2621)

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621

Mr. Thai Tran
SPE(2621)